

Appl. No. 10/733,649  
Amdt. Dated May 14, 2008  
Reply to Notice of Non-Compliant Amdt mailed 04-30-08

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### REMARKS/ARGUMENTS

As requested in the Notice of Non-Compliant Amendment mailed April 30, 2008, Applicants have now provided a listing of all claims including the missing text of claims 34-48. Below are the remarks/arguments previously provided in the Response to Office Action filed March 26, 2008.

### STATUS OF CLAIMS

#### **A. Total Number of Claims in Application**

There are a total of 14 claims pending in the instant application, namely Claims 28-33, 53, and 55-61.

#### **B. Status of all the claims**

Claims cancelled: 1-27, 34-52, 54, and 62-65

Claims pending: 28-33, 53, and 55-61

Claims allowed: none

Claims rejected: 28-33, 53, and 55-61

### GROUND FOR REJECTION

#### **Claim Rejections - 35 U.S.C. §112**

Claims 28-33, 53, 55 and 56 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, and further, under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejections are specifically directed to language in independent claim 28. Claim 28 has been amended to substitute language that more clearly defines the "first non-elasticized region being positioned between said elasticized region and said central body." Moreover, independent claim 28 has been amended to correct the recitation of the position of "the first elasticized region", on the second to the last line of the claim, to read instead, "the first non-elasticized region." Accordingly, independent claim 28 has been amended to adequately address the §112 rejections. Withdrawal of these rejections is respectfully requested.

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### Claim Rejections - 35 U.S.C. §102; §103

In the present case, the Examiner has rejected each of the claims on the grounds of obviousness under 35 U.S.C. §103. Claims 57-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,086,571 (hereinafter "Guevara"). Applicants submit that the Examiner has not properly established a *prima facie* case of obviousness for each of Claims 57-61. Each of the §103(a) rejections is, therefore, traversed.

It is well established that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The rule is obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *KSR International Co., v. Teleflex Inc.*, No. 04-1350, (US, April 30, 2007) (emphasis added).

### ARGUMENTS

#### **35 U.S.C. §103(a) Rejection of Claims 57-61 over Guevara (U.S. Patent No. 6,086,571)**

Claims 57-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,086,571 A ("Guevara"). Applicants respectfully traverse the rejection.

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The Examiner admits that Guevara does not teach that the elastic elements are generally perpendicular to the longitudinal centerline of the composite centerline. The Examiner asserts, however, that the Guevara elastic elements "do extend at a very obtuse or shallow angle that is almost 90 degrees or perpendicular to the composite longitudinal centerline." It is further asserted that modifying the Guevara composite such that the "almost parallel elastic threads are generally parallel elastic threads would not significantly change their stretch performance." Citing *In re Dailey*, the Examiner explains that the court has held that "mere changes in shape are not sufficient to patentably distinguish the invention over the prior art." That holding is not applicable, however, because the modifications to the Guevara construction suggested by the Examiner, if possible, amount to more than "mere changes in shape." In any event, the suggested modifications are not possible without some specific teaching as to how to successfully implement the modifications to produce a practical and workable product (as only provided by the present disclosure). Applicants submit that it is not such an easy task to modify Guevara so as to accomplish the structure of the claimed invention. The zig-zag pattern in Guevara are necessarily zig-zag because it was not probably known how to place a "plurality of" generally perpendicular, laterally directed, and/or mutually spaced apart elastic elements along the cross-machine direction, as configured according to claim 57. Alternatively, it was also not known how to do so in a manner that was practical or advantageous. There is no teaching in Guevara nor in any of the prior art cited to date that would allow a skilled artisan to accomplish the claimed configuration.

Furthermore, the Examiner has failed to cite a teaching or suggestion in the prior art to make the claimed combination or modification, and, more significantly, to establish the requisite reasonable expectation of success. Applicants note that the Examiner has not cited a need, or apparent reason, for replacing the zig-zag elastic thread with the spaced apart elastic elements, per claim 57. The zig-zag pattern appears, in fact, to be a dominant element of the Guevara invention and is even a limitation of the claimed invention. (See claim 3). Thus, the Examiner has also failed to meet his duty of providing, either in the cited references or in the knowledge generally available to one of ordinary skilled in the art, some suggestion, motivation, or "apparent reason" for the suggested modifications to the zig-zag pattern, in conformance with the invention of claim 57.

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For any of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness for each of claims 57-61.

The Examiner's basis for rejection is also improper because it ignores multiple important elements of claim 57. First, the Examiner has not cited a "plurality of spaced apart elastic elements" distributed and positioned as further defined in claim 57. The zig-zag elastic thread of Guevara is not a "plurality of elastic elements." Also, the zig-zag thread does not include elastic elements that are spaced apart. These "elastic elements" are probably of one zig-zag elastic thread because it was not known how to place a plurality of spaced apart elastic elements, as provided by the claimed invention. To construe the single zig-zag thread as a plurality of elastic elements defies the clear and plain meaning of the term "plurality." Applicants could not have defined this limitation and this distinction any more clearly. If Applicants intended to define "portions of a single elastic element" as being "spaced apart," it would have done so. To construe the single zig-zag thread as having a plurality of spaced apart elastic elements ignores clear and positive limitations in the subject claims.

Secondly, the zig-zag thread is clearly not in generally perpendicular relation with any centerline of the elastic belt, as also require by claim 57. These threads are clearly angled, and must be configured as such, to achieve the overall configuration in FIGS. 4-6. Applicants submit that it would be impossible to achieve the claimed elastic element configuration with the single zig-zag thread of Guevara (*i.e.*, a single thread that starts at the top of the belt corner and ends on the bottom of the belt). To construe the single pattern in these Figures as having some portions which may be "generally perpendicular" defies simple geometry. The portions of the Guevara zig-zag elastic thread cannot geometrically be 90 degrees or perpendicular to the composite longitudinal centerline. If that were the case, the zig-zag elastic thread could not traverse the entire width of the composite centerline because it would necessarily traverse one single path across the composite (back and forth over the same line).

Also, FIGS. 4, 5 and 6 of Guevara do not provide (i) an elastic construction that is spaced inwardly from each said side edge nor (ii) elastic elements (of the elastic construction) that are spaced inwardly from the side edge(s) to form a non-elasticized region between said first side edge and said elastic element, as recited in claim 57. The zig-zag thread that crosses the "composite centerline" is believed to extend to the actual side edges, where it is then covered by

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the landing or the body of the article. As is common in the art, the elastic belt of Guevara is probably provided separately and fed from a roll into a web substrate as a continuous strip of elastic belt. Each elastic belt is formed by cutting a discrete piece of this continuous strip. Thus, the elastics would necessarily extend continuously on the discrete piece and to the side edges. The same is believed to be the case for the zig-zag thread, although Guevara does not provide any clues in this matter.

FIG. 6A is the same structure as that discussed above in respect to FIG. 4, and thus is deficient, for the same reasons as discussed above. Moreover, the elastic belt of FIG. 6A is not spaced inwardly from the side edges as required by the subject claim. It is noted that the "non-elastic" region 120 of FIG. 6A is actually an extension tab 120 and thus, not a part of the elastic belt. The belt is attached directly to the extension tab at a side edge of the belt. The extension tab does not, therefore, provide a non-elasticized region of the elastic belt.

For any of the above reasons, the Examiner has failed to teach each and every element of claim 57 and, thus, failed to establish a *prima facie* case of obviousness.

#### AMENDMENTS

To expedite the present examination and to highlight the Applicants' contribution to the art, Applicants propose to amend claim 28 to also recite that the elastic elements are "disconnected" (as also provided in claim 28). The zig-zag elastic thread in the composite of Guevara is clearly of one continuous thread and thus, cannot be referred to as comprising "disconnected elastic elements."

Applicants also propose to amend claims 28 and 57 to recite that the elastic elements are "oriented along a lateral direction intersecting said longitudinal centerline." Pending claim 58, which depends from claim 57, already required "each said elastic element" to be "directed laterally." Also, original claim 1 contained the limitation requiring the elastic elements to be "oriented along a direction intersecting the longitudinal line." Thus, the proposed limitation has been considered in prior art searches and prior examinations. Applicants note also that the Examiner has already cited Guevara which provides portions of the zig-zag elastic element that are clearly lateral to the composite centerline (although not generally perpendicular). Further support for the amendment may be found in the Summary of the Invention, wherein Applicants

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describe an embodiment wherein "the elastic elements are oriented along a lateral direction that intersects the side edges and longitudinal centerline..." Para. 0007, Ins. 14-18. Accordingly, no new issues are raised with this amendment, no new subject matter is added, and there is no need for an additional prior art search.

Applicants note that, even with this amendment, Guevara still fails to teach spaced apart and disconnected elastic elements and elastic elements, and an elastic construction and elastic elements spaced inwardly from side edges, as further recited in claim 57. Thus, the arguments presented above still apply in showing that the Examiner has failed to establish a *prima facie* case of obviousness.

### CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

No fee is believed to be due at this time. If the appropriate Petition for an Extension of Time is not attached hereto (or any other Petition required of the application), this statement shall serve as Applicants' Petition to the U.S.P.T.O. The Commissioner is hereby authorized to charge any additional fees or credit any overpayments related to this response to Deposit Account No. 50-4228 (DSGI-1000US0), maintained by The Amatong Law Firm, PLLC.

The undersigned is available for consultation at any time, if the Examiner believes such consultation may expedite the resolution of any issues.

Date: 05/14/2008

Respectfully submitted,

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